

REMARKS

Claims 1, 3-9, 11-16, and 18-24 are pending and claims 1, 3, 9, 11-16, 18 and 21 are amended. In view of the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections.

Claims 1, 3-9, 11-16 and 18-24 stand rejected under 35 USC § 103(a) as being unpatentable over Goyal et al (5,873,108), Koyabu et al (6,026,333), Conmy et al (6,101,480) in view of Young et al (2004/0008971) and further in view of Net calendar Inc. to Launch Your Local Buzz-The First Wireless Local Event Service.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al. (550 U.S. 127 S. Ct. 1727 (2007))*) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior

art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

Applicant acknowledges that the Examiner agrees Goyal et al (5,873,108), Koyabu et al (6,026,333), Conmy et al (6,101,480) and Young et al (2004/0008971) do not teach "wherein the time of day profile correlates a clock time with at least one of a personal data category and a business data category." The Examiner also states that Net Calendar Inc. to Launch Your Local Buzz- The First Wireless Local Event Service (Business Editors/Hi-Tech Writers. Business Wire. New York: Mar 15, 2000. pg.1) teaches "wherein the time of day profile correlates a clock time with at least one of a personal data category and a business data category." Specifically the examiner quotes Business Wire, Page 1, Paragraphs 1-2 to Page 3 as containing the required information. Applicant submits, as stated in the previous response, that the Business Wire reference does not teach the invention as claimed. In fact, the Business Wire reference is disclosing subject matter that is not germane to the instant claims. The Business Wire reference teaches putting both personal and business related matters into the same calendaring system and allowing for reminders to be set based on a time and synch local events, as stated below:

NetCalendar plans to introduce the Weekend Buzz Planner(TM) service, which will allow consumers to receive via Internet phone, pager or PDA suggestions for local events that match their personal interests. The wireless implications for YourLocalBuzz.com events service are limitless, says Neumann.

NetCalendar's web-based calendar, DailyDrill.com (www.DailyDrill.com), already allows users to synch local events from their calendar with PDAs and desktop organizers. For example, a consumer can enter a meeting into their private DailyDrill.com calendar, then request that a reminder be sent to their digital pager one day before the meeting, then synch their DailyDrill.com calendar with their Palm V. All appointments and local events on DailyDrill.com

will flow into the consumer's handheld PDA. (Business wire page 2 paragraph 11 through page 3 paragraph 1)

Claim 1 does not mention “synching local events” or sending reminders to local pagers. Claim 1 states, in part, “determining a clock time of day...determining a day of a week...referencing a time of day profile...and setting a default category...based upon the clock time of day, the day of the week, and the time of day profile...” The Business Wire reference is not analogous to the present invention as claimed. As such, individually or collectively, the references do not teach the claimed matter. On that basis, reconsideration is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly addressed. Applicant therefore respectfully requests that the Examiner reconsider the outstanding rejections. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,
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